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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Docket Number (Optional)

3691-573

Application Number

10/622,834

Filed

July 21, 2003

First Named Inventor

THOMSEN

Art Unit

1755

Examiner

Bolden, Elizabeth A.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ Applicant/Inventor☐ Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)☒ Attorney or agent of record 37,515  
(Reg. No.)☐ Attorney or agent acting under 37CFR 1.34.  
Registration number if acting under 37 C.F.R. § 1.34 \_\_\_\_\_

Signature

Joseph A. Rhoa

Typed or printed name

703-816-4043

Requester's telephone number

January 23, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.\*

☒ \*Total of 1 form/s are submitted.

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of

THOMSEN et al.

Atty. Ref.: 3691-573; Confirmation No. 4771

Appl. No. 10/622,834

TC/A.U. 1755

Filed: July 21, 2003

Examiner: Bolden, Elizabeth A.

For: GREY GLASS COMPOSITION

\* \* \* \* \*

January 23, 2006

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Pursuant to the OG Notice of July 12, 2005, applicant hereby requests a pre-appeal brief review of this case for at least the following reasons.

**REMARKS**

Claims 1-31 are currently pending in the instant application.

**Boulos Rejection**

Claim 1 stands rejected under 35 U.S.C. Section 103(a) as being allegedly unpatentable over Boulos (US 2004/0102304). This Section 103(a) rejection is respectfully traversed for at least the following reasons.

Claim 1 requires a difficult-to-achieve *combination* of a grey glass having both (a) an IR transmittance (%IR) of no greater than 35%, and (b) a UV transmittance (%UV) of no greater than 40%. This combination of low IR% and low UV% is difficult to achieve, and *Boulos cannot* and does not achieve this claimed combination. In particular, Boulos cannot achieve a combination of both (a) an IR transmittance (%IR) of no greater than 35%, and (b) a UV transmittance (%UV) of no greater than 40%. Even though Boulos seeks good UV and IR properties, Boulos was not able to figure out how to achieve a grey glass which realizes both (a) and (b). Thus, it will be appreciated that claim 1 defines over Boulos for at least this reason. Moreover, there is nothing in Boulos which discloses or suggests this claimed combination. Furthermore, the fact that Boulos was unable to achieve this claimed combination (even though Boulos sought good IR and UV properties) evidences the unexpected results and inventiveness of the invention of claim 1. There is no teaching in the cited art as to how one could modify Boulos to meet claim 1.

Furthermore, applicant notes that when the claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options or embodiments disclosed by the reference, then the reference does not anticipate. *See Akzo N.V. v. United States Int'l Trade Commission*, 808 F.2d 1471, 1480 (Fed. Cir. 1986), *cert. denied*, 482

U.S. 909 (1987); *In re Arkley*, 455 F.2d 586, 587-88 (CCPA 1972). Thus, the PTO cannot randomly pick and choose different features from different embodiments of a reference in an attempt to meet the invention of a claim.

Claims 13 and 25 require a combination of both (a) an IR transmittance (%IR) of no greater than 35%, and (b) a UV transmittance (%UV) of no greater than 40%. Again, Boulos fails to disclose or suggest a grey glass capable of achieving this combination that is required by claims 13 and 25. Moreover, there is no reason why or how anyone could modify Boulos to meet these requirements of claims 13 and 25.

#### Arbab Rejection

Claim 1 stands rejected under 35 U.S.C. Section 103(a) as being allegedly unpatentable over Arbab (presumably 2003/0216242). The final rejection on page 3 states that Arbab is “2004/0102304.” However, this is clearly not correct, because this number is the publication number of Boulos – there is a clear typographical error in the final rejection. Thus, applicant has assumed that the Examiner was referring to Arbab 2003/0216242 in the final rejection. This Section 103 rejection is respectfully traversed for at least the following reasons.

Claim 1 requires very specific parameters including from *0.01 to 1.0 % cerium oxide*. Arbab fails to disclose or suggest this feature of claim 1. Moreover, there is no suggestion or motivation in the art of record which would have led one of ordinary skill to have modified Arbab to meet this requirement of claim 1. Applicant again notes that when a claimed invention is not identically disclosed in a reference, and instead requires picking and choosing among a number of different options or embodiments disclosed by the reference, then the reference does not anticipate. See *Akzo N.V. v. United States Int’l Trade Commission*, 808 F.2d 1471, 1480 (Fed. Cir. 1986), *cert. denied*, 482 U.S. 909 (1987); *In re Arkley*, 455 F.2d 586, 587-88 (CCPA

1972). One cannot randomly pick and choose different features from different embodiments of a reference in an attempt to meet the invention of a claim.

Moreover, there is nothing in Arbab which discloses or suggests this amount of cerium oxide. This amount of cerium oxide is important so as to allow the UV and IR characteristics to be maintained, and this amount of cerium oxide is not disclosed or suggested by Arbab.

Hindsight is not permissible.

Conclusion

For at least the foregoing reasons, it is respectfully requested that all rejections be withdrawn. All claims are in condition for allowance. If any minor matter remains to be resolved, the Examiner is invited to telephone the undersigned with regard to the same.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By: \_\_\_\_\_

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